

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FEDERICO DE H. MUZQUIZ

Appeal No. 1998-3425
Application 08/502,977¹

ON BRIEF

Before ABRAMS, FRANKFORT and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 4 through 9 as amended subsequent to the final rejection in a paper filed August 18, 1997 (Paper No. 10). Claims 4 through 9 are all of the claims remaining in the application. Claims 1 through 3 have been canceled.

¹ Application for patent filed July 17, 1995.

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Appellant's invention relates to a dispenser for dispensing single polyethylene bags from a roll of such bags. More particularly, the claimed subject matter, exemplified by independent claim 8, addresses the combination of a dispenser and a roll of polyethylene bags of a specific construction, which bag construction cooperates with the structure of the dispenser in a particular manner to enable only a single bag at a time to be dispensed from the roll of bags. A copy of independent claim 8 can be found in the Appendix to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Gluck	2,507,403	May 9, 1950
Shimasaki	5,097,998	Mar. 24, 1992
Wilfong, Jr. et al. (Wilfong)	5,207,368	May 4, 1993
Marshall (European Patent Application)	0427365A2	May 15, 1991

Claims 4 through 9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

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Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marshall in view of Wilfong.

Claim 4 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marshall in view of Wilfong as applied to claim 8 above, and further in view of Gluck.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Marshall in view of Wilfong and Gluck as applied to claims 4-6 above, and further in view of Shimasaki.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 16, mailed May 27, 1998) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed April 3, 1998) and reply brief (Paper No. 18, filed July 29, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first at the examiner's rejection of claims 4 through 9 under 35 U.S.C. § 112, second paragraph, we note that the examiner has taken the position that the recitations in the last clause of independent claim 8 regarding "a roll of polyethylene bags" and "a single central slot" represent a double inclusion of the same phrases previously recited, e.g., in lines 1 and 2 of the claim. We do not agree. Like appellant, we view the recitation in the preamble of claim 8 on appeal as merely setting forth the general type of dispenser being claimed, i.e., a dispenser "for dispensing

single polyethylene bags from a roll of polyethylene bags," while the last clause of the claim positively sets forth that the dispenser contains a roll of polyethylene bags of a specific construction, and that said specific bag construction cooperates with the plurality of truncated teeth of the dispensing slot of the dispenser in a particular manner to enable only one bag at a time to be dispensed from the roll of bags. Thus, it is clear to us that appellant is claiming a combination in the claims before us on appeal, wherein a specific form of dispenser and a specific form of polyethylene bags on a roll are set forth together as defining the subject matter appellant regards as his invention. Since we find no "double inclusion" problem in appellant's independent claim 8, it follows that the examiner's rejection of claim 8 under 35 U.S.C. § 112, second paragraph, and of claims 4 through 7 and 9 which depend therefrom, will not be sustained.

Regarding the examiner's rejection of claims 8 and 9 under 35 U.S.C. § 103 as being unpatentable over Marshall and Wilfong, we note, with respect to independent claim 8, that

the examiner has taken the position that it would have been obvious to one of ordinary skill in the art to modify the sawtooth-like teeth in the dispensing slot (32) of the plastic bag dispenser of Marshall, Figures 1-7, to be in a form wherein the teeth have "truncated crests and roots as taught by Wilfong" (answer, page 5), so as to facilitate a larger area of engagement for subsequent tearing of individual bags. As for the recitation in

the last clause of appellant's independent claim 8 that the dispenser must also contain "a roll of polyethylene bags separated by a single central slot and perforations" and the further requirement that the pair of opposed interdigitating toothed edge surfaces of the housing must be in engagement with "a central slot separating two bags to enable a single bag to be dispensed from the roll," the examiner has urged (answer, page 6) that

these limitations have not been given any patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

The examiner cites Ex parte Masham, 2 USPQ2d 1647 (BPAI 1987) as support for the above proposition.

Like appellant, we observe that the roll of polyethylene bags and the interrelationship between the structure of the bags and the structure of the dispenser set forth in the last clause of claim 8 on appeal are positive recitations clearly establishing that the claimed subject matter is a combination wherein a specific form of dispenser and a specific form of polyethylene bags on a roll are set forth together as defining the subject matter appellant regards as his invention. Thus, the examiner's attempt to dismiss these recitations as merely relating to intended use of the dispenser *per se* is entirely inappropriate, and for that reason alone we refuse to sustain the examiner's rejection of claims 8 and 9 under 35 U.S.C. § 103.

With regard to the examiner's use of a *per se* rule such as that derived from Ex parte Masham, we direct the examiner's attention to In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 425-26, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) wherein the Federal Circuit has held that the claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere

Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. § 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103.

As a further commentary, we also note that we share appellant's view that it would not have been obvious to one of ordinary skill in the art, based on the teachings of Marshall and Wilfong, to merely alter the configuration of the plurality of sawtooth-like teeth seen in the dispensing slot (32) of the bag dispenser of Marshall to be in a form like that set forth in appellant's claim 8 on appeal. If anything, it appears to us that the teachings of Wilfong would have been suggestive to one of ordinary skill in the art of replacing the plurality of sawtooth-like teeth in the dispensing slot of Marshall with an arrangement like that seen in Wilfong, wherein there is a pair of outer slot portions (e.g., 36, 37) separated by a single tongue (42). In this regard, we point to column 1, lines 11-36, in Wilfong wherein the patentee observes that zig-zag configuration slots, apparently like

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those seen in Marshall, are sensitive to changes in bag size and thickness of the plastic film and cause the dispensed bags to be wrinkled as they are withdrawn, whereas the configuration of the dispensing slot disclosed in the Wilfong patent is said to overcome those disadvantages of the zig-zag slot design. Given this situation, we see no reason why one of ordinary skill in the art would have been led to merely truncate the crests and roots of the sawtoothed edge surfaces in Marshall as is urged by the examiner, since such an arrangement would appear, because of the truncated teeth, to be even more sensitive to changes in thickness of the plastic film from which the bags are made than the sawtooth arrangement presently seen in Marshall. For this added reason, we refuse to sustain the examiner's rejection of claims 8 and 9 on appeal under 35 U.S.C. § 103 based on the collective teachings of Marshall and Wilfong.

We have also reviewed the teachings of Gluck and Shimasaki applied by the examiner against dependent claims 4

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through 6 and 7 on appeal. However, we find nothing in these prior art references which alters our view as stated above with regard to the basic combination of Marshall and Wilfong, that is, the patents to Gluck and Shimasaki do not supply that which we have found to be lacking in the examiner's combination of Marshall and Wilfong. Thus, the examiner's rejections of claims 4 through 7 under 35 U.S.C. § 103 will likewise not be sustained.

In view of the foregoing, the examiner's decision rejecting claims 4 through 9 of the present application under 35 U.S.C.

§ 103 is reversed. In addition, the examiner's decision

rejecting claims 4 through 9 under 35 U.S.C. § 112, second paragraph, is also reversed.

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REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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